



Attorney Docket No. P70693US0

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of TAKADA et al.

Confirmation No. 7831

Application No.: 10/541,619

Art Unit : 1791

Filed: July 7, 2005

Examiner: Jodi F. Cohen

For: ONE-PACK HARDENING PASTE MATERIAL FOR USE IN FOAMING MACHINE

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

**Mail Stop AF**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

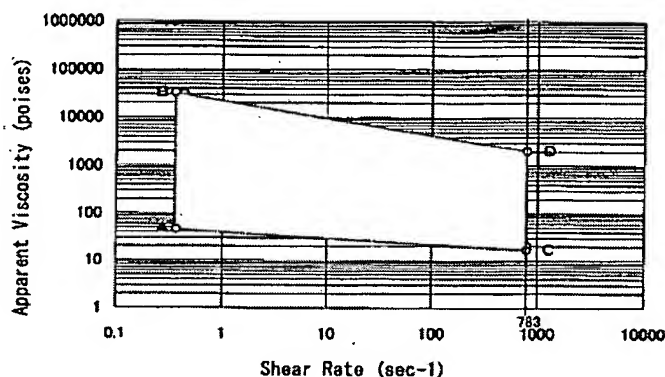
In response to the Final Office Action mailed December 22, 2009, as modified by the Advisory Action mailed April 2, 2010, please conduct a pre-appeal brief review of the above-identified application.

**ARGUMENTS**

The rejection of claims 7-16 under 35 USC 103(a) as being allegedly obvious over Okuda (JP 06 198152) ("040" in the statement of rejection) in view of Cobbs (US4778631) ("631" in the statement of rejection) and should be withdrawn because it is based on clear error. Specifically, clear error is committed by: (1) impermissibly relying on undirected "knowledge" in the art and "routine experimentation to optimize" claim variables in order to meet claim limitations that the rejection admits are missing from the cited references; and (2) failure to consider claim limitation (features) that are absent from the cited references.

As an initial matter, the examiner correctly pointed out (in the Advisory Action) that conversion from "poise" to "cps" was incorrectly calculated in the after final response. The error is regretted.

(1) Impermissible Reliance On Undirected "Knowledge" And "Routine Experimentation To Optimize" Claim Variables: The rejected claims are limited to a "paste material" that must have the "viscosity characteristics" found "in the graph"



showing the relationship between shear rate and apparent viscosity, the points A and B being at 50-30000 poises of an apparent viscosity...in low shear rate region (0.43 sec<sup>-1</sup>) and the points C and D being at 20-2000 poises of an apparent viscosity...in high shear rate region (783 sec<sup>-1</sup>)

The rejection admits Okuda "does not teach the...shear rate properties...in claim 7" and Cobbs "is silent about the shear rate" (Office Action mailed 06/09/2009, page 5) (emphasis added). Support (in the prior art) for the absent "shear rate" limitation is nonetheless found in the routineer's *knowledge of basic physics*, i.e.:

Basic physics teaches us that...[f]or shear-thinning fluids the viscosity decreases with the increase in shear. One of ordinary skill in the art at the time of the invention would have this knowledge and thus it would be obvious with routine experimentation [to] optimize the shear rate of the substance to obtain the desired viscosity.

(Advisory Action mailed 04/02/2010, page 3) (emphasis added). The fallacy (clear error) of this finding *on its face* is readily apparent.

Reliance on "routine experimentation to optimize" claim variables has been repeatedly discredited as a basis for obviousness: When obviousness of a claim limitation is grounded on its allegedly being "old and well known in the art...as a means of optimization which is highly desirable," the "ground of rejection is simply inadequate on its face." *In re Thrift*, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002) (emphasis added). That a difference with the prior art amounts to an

alleged "optimal condition ... is not a substitute for some teaching or suggestion supporting an obviousness rejection." *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (emphasis added). Finding obviousness based "upon routine experimentation is contrary to the last sentence of section 103." *In re Yates*, 211 USPQ 1149, 1151 n.4 (CCPA 1981). Accordingly, reliance on "routine experimentation [to] optimize the shear rate" renders the rejection untenable.

Moreover, the presumed "knowledge" of how "to obtain the desired viscosity" of a substance given its "shear rate" is of no use when the "shear rate" is not given—as in the present case where the prior art "does not teach," and "is silent about," the "shear rate" limitation "in claim 7," as admitted in the rejection, itself (explained above).

In other words, the "knowledge" relied on establishes at best, that the routineer had the requisite skills to carry out the presently claimed method, which fails to establish *prima facie* obviousness and, so, renders the rejection untenable. "That which is within the capabilities of one skilled in the art is not synonymous with obviousness [citations omitted]." *Ex parte Levengood*, 28 USPQ2d 1300, 1302 (Bd. Pat. App. & Inter. 1993).

[Where] the examiner's comments regarding obviousness amount to an assertion that one of ordinary skill in the relevant art would have been able to arrive at appellant's invention because he had the necessary skills to carry out the requisite process steps...is an inappropriate standard for obviousness.

28 USPQ2d at 1301 (emphasis added). "We have previously rejected the argument that undirected skill of one in the pertinent art is an adequate substitute for statutory prior art [citation omitted]." *In re Kratz*, 201 USPQ 71, 76 (CCPA 1979). The "presumed knowledge [of how to apply a reference's teachings] does not grant a license to read into the prior art reference teachings that are not there." *Motorola Inc. v. Interdigital Technology Corp.*, 43 USPQ2d 1481, 1490 (Fed. Cir. 1997).

What apparently was forgotten in rejecting the claims is that "invention" involves both the *idea* (conception) of the invention as well as the *means* (enablement) to achieve the desired idea, and both the idea and the means must be found in the prior art to negate patentability. *Oka v. Youssefyeh*, 7 USPQ2d 1169 (Fed. Cir. 1986). *In re Coker*, 175 USPQ 26 (CCPA 1972). *In re Hoffman* 37 USPQ 222 (CCPA 1938). In the present case, the "knowledge" relied on provides,

at best, only the *means* aspect of invention, which fails to establish *prima facie* obviousness.

**(2) Ignoring Claim Limitations That Distinguish The Prior Art:** As readily apparent from the claim "graph" (above), the upper limit of the viscosity range (line B→D) decreases more/faster than the lower limit (line A→C) as the "shear rate" (i.e., applied stress) increases; whereas, the upper limit decreases a total of 28,000 poises (from 30,000 to 2,000), the lower limit decreases a total of only 30 poises (from 50 to 20). Moreover, the viscosity/shear-rate "relationship" is not *linear*; "viscosity" is not defined over a single range, but over a region of ranges, i.e., the area defined by "the points A and B... and the points C and D" in the graph.

Nevertheless, the rejection never once mentions the ranges (limitations) "50-30000 poises" and "20-2000 poises," which define the limits of the "viscosity"—based on the lower and upper limits (from 0.43 to 783 sec<sup>-1</sup>) of "shear rate." The rejection merely refers to disclosure in Cobbs that (allegedly) meets these limitations, i.e., Cobbs ('631) "discloses using a high viscosity...adhesive to produce an expandable [foam], wherein the adhesive has high viscosities ranging from 22 poises-400 poises, 500 poises to above 10,000 poises" (Office Action mailed 06/09/2009, page 4). Failure to account for the "50-30000 poises" and "20-2000 poises," renders the rejection untenable.

When conducting an obviousness analysis, "all limitations of a claim must be considered in determining the claimed subject matter as is referred to in 35 U.S.C. 103 and it is error to ignore specific limitations distinguishing over the reference[s]." *Ex parte Murphy*, 217 USPQ 479, 481 (PO Bd. App. 1982). Cobbs neither teaches nor suggests viscosities that fall in a series of ranges between (and including) the range "50-30000 poises" and the range "20-2000 poises." At best, Cobbs discloses viscosities that fall exclusively within two separate ranges; in other words, excluding viscosities that do not fall within either "22 poises-400 poises" or "500 poises to above 10,000 poises."

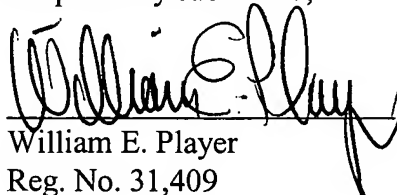
Moreover, any alleged overlap between the claimed viscosities and Cobbs' viscosities is insufficient to establish the obviousness of the claimed viscosities. *Ex Parte Wittpenn*, 16 USPQ2d 1730, 1731 (BPA&I 1990). Specifically, *Wittpenn* held (emphasis added)

in the absence of some motivation to select a neutral pH, the Examiner's conclusion lacks any logical foundation ... [such] that no *prima facie* case of obviousness has been established ... [there being] no disclosure within the reference that would have led the routineer to make the critical selections to arrive at the claimed surfactant composition.

Accordingly, "in the absence of some motivation to select" the claimed viscosities from Cobb's alleged viscosity ranges of "22 poises-400 poises, 500 poises to above 10,000 poises" "the Examiner's conclusion lacks any logical foundation" and, so, "no *prima facie* case of obviousness has been established." *Wittpenn*, 16 USPQ2d at 1731. *See In re Baird*, 29 USPQ2d 1550 (Fed. Cir. 1994) ("The fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious"). *See also In re Belle*, 26 USPQ2d 1529 (Fed. Cir. 1993); *In re Jones*, 21 USPQ2d 1941 (Fed. Cir. 1992).

**CONCLUSION** For the foregoing reasons, the final rejection under §103(a) cannot be sustained and, accordingly, reversal of the rejection is in order.

Respectfully submitted,



William E. Player  
Reg. No. 31,409  
Attorney of Record

JACOBSON HOLMAN PLLC  
400 Seventh Street, NW  
Washington, D.C. 20004  
Tel. (202) 638-6666  
Fax (202) 393-5350  
Date: May 21, 2010  
WEP/mwb  
P70693US0 pre.app.brief(draft)(rev).doc